



UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of) **MAIL STOP**
Wolfgang Moderegger, et al.) Group Art Unit: 3627
Application No.: 09/944,379) Examiner: Oger Garcia Ade
Filing Date: September 4, 2001) Confirmation No.: 1270
Title: METHOD AND SYSTEM FOR)
MANAGING INVITATIONS TO BID)

REPLY BRIEF/ORAL HEARING TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is enclosed.
- ☐ _____ Terminal Disclaimer(s) and the ☐ \$ 65 ☐ \$ 130 fee per Disclaimer due under 37 C.F.R. § 1.20(d) are enclosed.
- ☐ Also enclosed is: Request for Oral Hearing
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$ 405 ☐ \$ 810 fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted _____ on _____ for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	43	58	0	x \$ 50 (1202)	\$ 0
Independent Claims	1	7	0	x \$ 210 (1201)	0
<input type="checkbox"/> If Amendment adds multiple dependent claims, add \$ 370 (1203)					\$ 0
Total Claim Amendment Fee					\$ 0
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					0
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0

- ☐ Charge _____ to Deposit Account No. 02-4800 for the fee due.
- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to credit card for the fee due. Form PTO-2038 is attached.
- ☒ The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date December 5, 2007

By: 

Charles F. Wieland III
Registration No. 33096

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of.)	MAIL STOP AMENDMENT
Wolfgang Moderegger et al.)	Group Art Unit: 3627
Application No.: 09/944,379)	Examiner: Oger Garcia Ade
Filed: September 4, 2001)	Confirmation No.: 1270
For: METHOD AND SYSTEM FOR)	
MANAGING INVITATIONS TO BID)	

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer dated October 5, 2007, applicants offer the following comments.

At page 10, Section (10) "Response to Argument," the Examiner maintains that the claim language surrounding the phrase "unpriced performances" is merely descriptive language, not adding to the functionality of the system. It is respectfully submitted that the Examiner is clearly taking the phrase out of context and that within the context it is much more than mere descriptive matter, but instead affects the functionality of the system. As illustrated below, appellants believe that the present invention is clearly separate from the processes identified in Fields¹.

¹ The present application was filed on September 4, 2001 and claims priority of October 20, 2000, to German application 10052214.9. All claims of the present application should be entitled to the priority of October 20, 2000. Fields (US 2002/0069154 A1) claims to be a Continuation-In-Part of Application No. 09/710,779 filed on November 9, 2000, and, perhaps through a typographical error, priority to non-provisional of Provisional Application No. 60/164,494 filed on November 9, 1999. This provisional application has no common inventor and no overlapping disclosure with respect to the applied Fields publication. At this time, Appellants have elected to argue the merits, giving the clarity of the technical distinctions, rather than perfect their priority claim to remove Fields as a reference.

Fields discloses an RFP system helping clients to contract attorneys. The pair "client-attorney" of Fields corresponds to the pair "buyer-bidder" of the present invention. Fields allows the client to select performances desired from the attorney by interaction with various web pages.

According to Fields, the client/buyer uses the interface shown in Figure 14 to identify the complexity of a mechanical invention based on number of components, moving parts and others, and further based on a region. Based on this information, the system calculates a fee using "iffee grids" as shown in Figure 31 (see paragraph [0086]).

Thus, the client can change the fee calculated by the system only by changing information relating to the complexity of the invention or region.

If the client/buyer accepts the RFP, it is sent to the attorney/bidder.

"The attorney can accept, reject or delete the RFP" (see paragraph [0088]). Since the attorney/bidder can only accept or refuse the RFP, it is apparent that the RFP does not represent an invitation for bids including prices. The attorney/bidder according to Fields has no possibility to propose a price for which he is willing to perform the work.

From this difference it is apparent that the system according to Fields is completely different from that according to the present invention.

In other words, according to Fields the buyer selects the work to be done, the system determines the price to be paid to the bidder for effecting the prospective work, a description of the work plus price information is sent to the bidder, and the bidder can refuse or accept.

In marked contrast, according to the present invention, the buyer selects the performance, the performance is transmitted to the bidder and the bidder determines the price to be paid for effecting the respective performance. The performance plus price information is sent to the buyer.

According to the present invention, the prices are determined by the bidder, rather than by the system.

The differences between the systems according to Fields and according to the present invention are reflected in present claim 1. Claim 1 defines that unpriced performances are forwarded to the bidders, and that the bidders perform the input to a bid mask stating the price to be paid to the bidder for effecting the respective performance.

On the bottom of page 3 the Examiner argues that the received bid includes a bid price input to a bid mask by the bidder and refers to "e.g. customized fee quote based upon client inputs." It is respectfully submitted that this passage of the Examiner's Answer best illustrates one of the logical errors underlying the Examiner's rejection insofar as in the context of Fields, the "client" is clearly not the bidder in the context of the present claims.

The Examiner submits that the recitation of "unpriced performances" neither enhances nor diminishes the functionality of the system. However, the above comments clearly show that the feature "unpriced" is one of those features that distinguishes the present invention from Fields and that effects the information and the transaction flow. Note for example the last step of claim 1 would not make sense if the bid were priced (e.g., there would be no reason to "[update] the database such that, for each performance of the generated list of performances for which the bid

was selected, the price description in the database corresponding to said performance is modified to reflect the selected bid, wherein at least the updating is performed by a computer."). See, e.g., paragraph [0057] of the published version of the present application for an explanation of the advantages of this process.²

With respect to these recitations, the Examiner's citation to paragraph [0028] for support of his position is not understood since this passage states:

A further embodiment of the present invention, a method for electronically managing communications between an intellectual property attorney having particular qualifications and a potential client seeking a solution to a legal problem, comprising the steps of providing a control unit having a database for storing therein a plurality of intellectual property practitioners, providing an interface to an end user to the system to formulate a request for proposal in conjunction with a request for legal services including a fee quote generated by the system based upon a plurality of inputs, sending out the request for proposal to a plurality of intellectual property practitioners who may respond to the request for proposal.

Further, according to Fields, "priced RFPs" are forwarded to attorneys, whereas "unpriced performances" are forwarded to the bidders according to the present invention. This difference is essential for understanding that the systems according to the present invention and according to Fields are completely different systems and perform completely different functions. The understanding of the Examiner that "unpriced performances" is non-functional descriptive material that he did not give any patentable weight, is improper. See, *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983).

Appellants separately argued several of the dependent claims, and it is apparent from the record (if only by the imposition of a restriction requirement that

² The Appeal Brief of August 20, 2007, included a typographical error in citing to paragraph [0055] of the specification for support of this last step of claim 1.

requires a determination of separate patentability) that the dependent claims add further patentable distinctions.

In regard to claim 3, the Examiner suggests at page 11 of the Answer that the client in Fields can update the number of moving parts of a mechanical invention as part of its process of pricing the RFP, but this fails well short of "updating the database [that] includes automatically updating the price description corresponding to bid performances *whose performance description was not modified*" as recited in claim 3. The same general comment applies to the Examiner's comments regarding claim 14 at page 11, where the features pointed to in Fields seems to have little to do with "determining a plurality of bidders to which to forward the list of performances [being] based on a history of past performances by the bidders."

The Examiner does not rebut Appellants' arguments regarding claims 12, 22 or 23.

Further, the Examiner has not provided a reason or cited a teaching or suggestion for the alleged combination of references. Instead, at page 12 of the Answer, he explains his views on what constitutes "analogous art", which was not a point raised by Appellants.

Furthermore, all that is necessary to overcome the Examiner's rejections is to identify an element of the claims that is not met or suggested by the prior art. According to M.P.E.P. § 2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is respectfully submitted that Appellants have crossed this threshold in abundance.

CONCLUSION


In conclusion, applicants respectfully submit that they have pointed out ample support for the position that the claims not only are not anticipated, but are not rendered obvious by the applied prior art. Accordingly, appellants respectfully request that the Examiner's rejection be reversed and the application pass to issuance.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: December 5, 2007

By:


Charles F. Wieland III
Registration No. 33096

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620